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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,575	01/08/2002	Joachim Schicke	31512-176923	1434

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VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP  
P.O. BOX 34385  
WASHINGTON, DC 20043-9998

EXAMINER
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ROSS, DANA

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 05/07/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/038,575

Applicant(s)

SCHICKE, JOACHIM

Examiner

Dana Ross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

1. This is a second office action, final rejection on Application No. 0/038,575 in response to the amendment filed on April 16, 200.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-22, 24-25, and 27-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,830,126 (Ringe) in view of U.S. Pat. No. 5,217,424 (Pallmann) or U.S. Pat. No. 975,563 (Morgan).

Ringe teaches the method and apparatus cutter with a knife blade for severing wrapped tobacco filler rods or the like. Pallmann or Morgan teach the apparatus and method of automatically inserting and removing a knife blade by unlocking the knife, removing the knife and replacing the knife with another knife fed in a linear manner from a storage device or magazine. One possessing ordinary skill in the art would have expected to make the manual knife changing method of Ringe to be automated as taught by the apparatus and method in the operation of the devices of Morgan or Pallmann, as the benefits such as reduced down time for the apparatus and increased operator safety that accrue to the use of automated exchanging devices is well-known and explicit in Pallmann (col. 1 and 2) and Morgan (page 1, lines 1-30).

*Allowable Subject Matter*

4. Claims 23 and 26 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

5. Applicant's arguments filed April 16, 2003 have been fully considered but they are not persuasive.

Applicant argues that Ringe does not teach a cutter with a knife blade that is discrete and exchangeable. Examiner disagrees with Applicant's statement. Ringe teaches a knife 28. Ringe teaches a purpose of the knife is to "insure the formation of clean cuts" (col. 1, lines 24-25). It is inherent that the knives are discrete and exchangeable. To further base this knowledge, Pallman is referenced which teaches a method for automatically exchanging knives in a knife ring.

Applicant states that Ringe fails to disclose that the knife blades are replaceable even manually. Ringe discloses the knives for severing wrapped tobacco filler rods or the like except for specifically stating that the blades are replaceable. Even if the holder and knife blades were formed integrally as one part, and the holder formed integrally with the knife ring, and the entire knife ring were replaced when the knives got dull or broken, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the knife ring, knife holder and knife as individual parts, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Newin v. Erlichman*, 168 USPQ 177, 179.

In response to applicant's argument that Morgan and Pallman are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not,

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then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Ringe teaches the specifics of the apparatus and method for severing wrapped tobacco filler rods or the like, including the use of a knife or knives. Ringe does not disclose the specifics of replacing the knife blade. Pallmann and Morgan disclose a method and apparatus for automatically exchanging knives, including automatic locking of the knife to a tool holder and removing the knife from the tool holder. Whereas applicants invention is directed to severing smoker's products, the method involves the replacement of knives as disclosed by both Ringe and Pallmann.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ringe teaches severing the smoker's products with the use of a knife blade, while Morgan and Pallman teach automatically replacing the cutter knives.

Applicant states that Pallmann does not replace the knife in the cutting apparatus as required by the claims. It is not clear what is being defined by "cutting apparatus" since Applicant further states Pallmann teaches replacing the knife blades of the knife ring, which is part of the cutting apparatus (page 5, 4<sup>th</sup> paragraph).

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*Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is (703) 305-7764. The examiner can normally be reached on Mon-Fri 7:00am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

dmr  
April 30, 2003

  
A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700